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Ex parte THOMAS E. MITCHELL and WILLIAM LEE ROBERTS

Appeal No. 2002-1798

Application 09/238,804 n1

n1 Application for patent filed January 28, 1999, entitled "Violation Alert Speed Display," which is a continuation of Application 08/933,152, filed September 18, 1997, now U.S. Patent 6,046,686, issued April 4, 2000.

Board of Patent Appeals and Interferences

2001 Pat. App. LEXIS 66

August 9, 2001, Decided

[\*1]

Before BARRETT, RUGGIERO, and SAADAT, Administrative Patent Judges.

**OPINIONBY: BARRETT**

**OPINION:**

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

**ON BRIEF**

BARRETT, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 26-35.

We reverse and remand.

**BACKGROUND**

The invention relates to a vehicle speed measuring and display device that displays an approaching vehicle's speed on a digital display at a subdued, steady state when the speed is under the legal speed limit and at a highly visible, warning state when the speed is above the legal speed limit. The warning state may be provided by flashing or an accentuating color. n2

n2 It is noted that many companies manufacture radar speed monitors with a speed alarm option that flashes the speed when the speed limit is exceeded, e.g., MPH Industries ([www.mphindustries.com/products\\_home/monitor\\_trailers2.html](http://www.mphindustries.com/products_home/monitor_trailers2.html)), Traffic Display Monitor Co. (1-radar-speed-trailer-display.com/feature.htm), McCoy's Lawline ([www.policeradar.com/RadarTrailer2.htm](http://www.policeradar.com/RadarTrailer2.htm)). These were found with a Google search using "radar speed displays." However, the date these devices were first made is unknown and appellants have an effective filing date of September 18, 1997. Since it is known that many commercial devices will infringe any patent that may issue on this application, it is in the best interests of both the public and appellants to have the best possible rejection made in the first instance.

[\*2]

Claim 31 is reproduced below.

31. A vehicle speed measuring and display device comprising:

a mobile display structure adapted to be positioned at a roadside location where it can be seen by a driver of an approaching vehicle,

means for providing a signal indicative of the actual speed of a vehicle approaching said structure,

means on said structure responsive to said signal for displaying said vehicle's speed in a digital form, said display means having electrically responsive indicia for displaying at least two numeric digits,

means for comparing said signal with a selected threshold speed that is related to the legal speed limit for the road by which the vehicle's speed is to be displayed, and

means responsive to said comparing means for energizing said indicia in a subdued, steady state in the digits corresponding to the vehicle's speed when the vehicle's speed is below said threshold speed, and energizing said indicia in a highly visible, warning state in the digits corresponding to the vehicle's speed when the vehicle's speed is above said threshold speed.

The examiner relies on the following references:

McClellan, Sr. et al. (McClellan)	3,691,525	September 12, 1972
Strickland	5,231,393	July 27, 1993
Haeri	5,659,290	August 19, 1997
[*3]		

Claims 26, 27, 31, and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Strickland and Haeri.

Claims 28-30 and 33-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Strickland and Haeri, further in view of McClellan.

#### OPINION

Appellants argue that the obviousness rejection cannot stand because the examiner did not address the objective evidence of nonobviousness (Brief, pp. 28-31; Reply Brief, pp. 8-9).

Objective evidence (also called "secondary considerations") is one of the four mandatory factual inquiries under *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and must always be considered, when present and timely presented, as part of the obviousness determination, *Stratoflex Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-39, 218 USPQ 871, 879 (Fed. Cir. 1983). The existence of objective evidence need not be conclusive. *Ashland Oil, Inc. v. Della Resins & Refractories, Inc.*, 776 F.2d 281, 306, 227 USPQ 657, 674 (Fed. Cir. 1985). [\*4]

Appellants submitted a report by Speed Measurement Laboratories, Inc. (SML) dated July 11, 2000, in the Response Under 37 C.F.R. § 1.116 (Paper No. 11) received October 2, 2000. In the Advisory Action (Paper No. 13) entered November 7, 2000, the examiner merely checked the box stating that "The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:" and filled in the blank that "The examiner still believes that the independent claims 26 and 31, as stands, are not patentably distinguished over the obviousness rejection as taught by Strickland in view of Haeri." The examiner did not provide a written explanation addressing the merits of the SML report as part of the obviousness analysis. Appellants also filed a Declaration of Steven F. Hocker Under 37 CFR § 1.132, with an attached Exhibit 1 showing a brochure of a speed monitoring awareness trailer manufactured and sold by Kustom, the assignee of the present invention, under the trademark SMART, and an attached Exhibit 2 showing a sample quotation showing a price of \$ 250 for the violator alert feature (Paper No. 17), received May 7, 2001, with a discussion [\*5] of this evidence (Paper No. 16), received May 7, 2001. In the next Advisory Action (Paper No. 18) entered June 4, 2001, the examiner checked the boxes that "The request for reconsideration has been considered but does NOT place the application in condition for allowance because:" and filled in the blank that "The claims, as stands, are not patentably distinguished over the obviousness rejection as taught [by] Strickland (US 5,231,393) in view of Haeri (US 5,659,290)." The examiner did not provide a written explanation addressing the merits of the Hocker declaration or the earlier SML report as part of the obviousness analysis.

Thus, appellants timely submitted objective evidence of nonobviousness, which was apparently considered by the examiner. However, there is absolutely no written discussion of the objective evidence in the record and, in particular, absolutely no written discussion in the examiner's answer. The examiner's answer is conspicuously silent in response to appellants' arguments that the objective evidence was not addressed. Since objective evidence must always be considered as part of the obviousness analysis when timely filed, the examiner has failed to perform a [\*6] complete Graham v. John Deere analysis. Accordingly, the rejections of claims 26-35 are reversed and the case is remanded for the examiner to provide a written analysis of the objective evidence of nonobviousness. n3

n3 We reverse to make it clear that appellants may be entitled to a term adjustment in any patent which may issue. We remand so that the examiner need not seek permission of the Director to reopen prosecution under 37 CFR § 1.198.

In addition, since the examiner must reopen prosecution to consider the objective evidence of nonobviousness, we take this opportunity to point out better prior art that should be added to the rejection in the interest of presenting the best possible case (see footnote 2). First, the reference to Carey et al. (Carey), U.S. Patent 3,544,958, cited by appellants in the background of the invention (specification, p. 1), shows a roadside speed display sign having a digital speed display 22. When the measured speed is above the legal limit, red warning sign 26, which reads "Your Speed Is," red warning sign 23, which reads "Slow Down," and warning light 25 will be lit in addition to the speed indicator 22; when the measured speed is [\*7] below the legal limit, green approval sign 27, which reads "Your Speed Is," and green approval sign 24, which reads "Safe Drivers Live," are lit in addition to the speed indicator 22 (col. 3, lines 9-50). Thus, Carey teaches using different colors to indicate speeds above and below the speed limit, albeit not of the indicator digits themselves. It is not known why the examiner did not rely on Carey. Second, Strickland describes Clegg, U.S. Patent 3,054,087, in the background of the invention, as a traffic warning system where Figs. 2A and 2B "have indicia that light up when the predetermined speed is exceeded" (col. 2, lines 10-11). Thus, Strickland teaches providing a visual indication when a speed limit is exceeded, which provides motivation for providing specific visual indications. The examiner did not mention or rely on this part of Strickland in the rejection. Third, Clegg teaches that the speeding light indicator can be steady state or flashing (col. 2, lines 24-25) and that the word "Exceeding" in a different color than the rest of the sign can be illuminated to indicate speeding (col. 3, lines 8-43). Thus, Clegg teaches a flashing light to indicate speeding. The addition [\*8] of Carey and Clegg to the rejection would strengthen the rejection and simplify the arguments. It also seems that Carey is a much better reference than McClellan.

#### CONCLUSION

The rejections of claims 26-35 are reversed and the application is remanded to the examiner for consideration of the objective evidence of nonobviousness and such further action as may be appropriate in view of our comments.

REVERSED AND REMANDED